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EXAMINER

NGUYEN, CHAU T

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 09/24/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/557,196

Applicant(s)

PERLMAN, STEPHEN G.

Examiner

Chau Nguyen

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2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Amendment A, filed on 07/08/2003, has been entered. Claims 1-14 are presented for examination.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kurtz, Patent No. 5,574,440, in view of Houser et al. (Houser), Patent No. 5,774,859, and further in view of Brooks et al. (Brooks), U.S. Patent No. 5,826,166.

4. As to claims 1, 5, 6, 8-9, and 11-12, Kurtz discloses in a home entertainment system including a central device coupled to a plurality of electronics devices, wherein the plurality of electronics devices includes a display device and a descrambler, and wherein the central device manages the operation of the plurality of electronics devices,

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a method for tuning channels that are requested by a user for display on the display device, the method comprising the steps for:

receiving user input at the central device, wherein the user input selects a channel that corresponds to a signal carrying programming, and wherein the signal is received by the entertainment system (Abstract, col. 1, line 11 – col. 2, line 7, col. 3, lines 15-39, and Fig. 1: switching apparatus 10 (the central device) is employed with an entertainment installation having a cable signal passing through a cable convert box (descrambler), and user can use a remote control to select a channel);

determining at the central device whether the signal is scrambled or non-scrambled (Abstract, col. 2, line 37 – col. 3, line 11, col. 4, line 47 – col. 5, line 21 and Fig. 1: the central device has green and red light emitting diodes (LEDs) which indicate the signal is scrambled (premium) or non-scrambled (non premium));

if the signal is determined to be scrambled, performing the steps for:

routing the scrambled signal from the central device to the descrambler (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: the premium signal is output to a converter box (descrambler)); and

using the descrambler to descramble and tune to one or more channels of the scrambled signal for display on the device (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: the output of a cable converter box suited for a cable ready TV tuning system); and

if the signal is determined to be non scrambled, performing the step for:

using an internal tuner at the central device to tune to one or more channels of the non-scrambled signal for display on the display device (col. 3, line 40 – col. 4, line 12, col. 4, line 47 – col. 6, line 18, and Fig. 1 & Fig. 2: where the signal source selected is a non-premium (non-scramble) channel input, the viewer is provided the use of all the various built-in programming and television receiver).

However, Kurtz does not disclose electronic programming guide (EPG) data stored at the central device. In the same field of endeavor, Houser discloses EPG data, from information provider, is stored in memory at subscriber terminal unit 160 (central device) (col. 23, lines 7-37 and Fig. 2C). Houser teaches a subscriber terminal unit 160, is coupled to plurality of devices such as televisions, VCR, computer, and the like, which is similar to the system of Kurtz. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Kurtz and Houser to include EPG data at the central device because EPG provide television schedule information arranged by time and channel for programs up to a few hours in advance.

However, Kurtz and Houser do not disclose an internal tuner is located at the central device. In the same field of endeavor, Brooks discloses NIM (network interface module) controller 510 provides a network interface between the host DET (digital entertainment terminal) and all elements of NIM 101, and the network interface

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comprising an RF tuner 501 (Fig. 3, Fig. 5, and col. 19, lines 38-65, col. 20, lines 13-19, col. 20, lines 60-67, and col. 25, lines 40-60). Since Brooks teaches a digital entertainment terminal is adapted to begin execution of other application in re response to an input from a user's remote control, which is similar a method for switching between two or more RF signal sources while employing the hand held remote control supplied of Kurtz and Houser, thus it would have been obvious to one of ordinary skills in the art at the time the invention was made to combine the teachings of Brooks and Kurtz and Houser to include an internal tuner locating at the central device to enhance the system.

5. As to claims 2, 7 and 14, Kurtz, Houser, and Brooks (Kurtz-Houser-Brooks) disclose after descrambling and tuning the scrambled signal at the descrambler, performing the step for sending the descrambled and tuned signal from the descrambler to the central device (Kurtz, col. 10, line 3 – col. 11, line 5).

6. As to claims 3 and 13, Kurtz-Houser-Brooks disclose wherein the descrambler is a cable box (Kurtz, col. 5, lines 53-67).

7. As to claims 4 and 10, Kurtz-Houser-Brooks disclose wherein the user input is sent to the entertainment system by a remote control device (Kurt, col. 4, lines 47 – col. 5, line 21).

Response to Arguments

In the remarks, Applicants argue in substance that

(A) Prior does not discuss using an internal tuner located at the central device for tuning into descrambled channels.

As to point (A), in response to applicant's argument that the prior art fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., in the Amendment, "using an internal tuner located at the central device for tuning into descrambled channels" (page 6, lines 15-16) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

(B) Prior art inherently teaches away from using an internal tuner located at a central device for tuning non-scrambled signals to one or more channels.

As to point (B), Brooks discloses NIM (network interface module) controller 510 provides a network interface between the host DET (digital entertainment terminal) and all elements of NIM 101, and the network interface comprising an RF tuner 501 (Fig. 3,

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Fig. 5, and col. 19, lines 38-65, col. 20, lines 13-19, col. 20, lines 60-67, and col. 25, lines 40-60).

(C) Prior art fails to disclose using electronic program guide data stored at a central device, where the stored data determine whether portions of an incoming signal are scrambled or non-scrambled.

As to point (C), Houser discloses EPG data, from information provider, is stored in memory at subscriber terminal unit 160 (central device) (col. 23, lines 7-37 and Fig. 2C). Brooks also discloses the digital entertainment terminal loads navigation software, which may also be implemented as a menu program operating as an electronic TV Guide (col. 13, lines 33-53). Kurtz discloses the central device has green and red light emitting diodes (LEDs) which indicate the signal is scrambled (premium) or non-scrambled (non premium) (Abstract, col. 2, line 37 – col. 3, line 11, col. 4, line 47 – col. 5, line 21 and Fig. 1).

8. Applicant's arguments filed on 07/08/2003 have been fully considered but they are not deemed fully persuasive. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection as explained above, necessitated by Applicant's substantial amendment (i.e., electronic programming guide data stored at the central device, and internal tuner is located at the central device) to the claim(s) which significantly affected the scope thereof.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau Nguyen whose telephone number is (703) 305-4639. The examiner can normally be reached at 8:00 am – 5:00 pm Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (703) 305-9792. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3230.

Any response to this final action should be mailed to:

Box AF

Commissioner of Patents and Trademarks
Washington, D.C. 20131

Or Faxed to:

(703) 872-9306, (for **formal communications**; please mark
"EXPEDITE PROCEDURE").

Or:


(703) 746-7240 (for **informal or draft communications**, please label
"PROPOSED" or "DRAFT").

Or:

(703) 746-7238 (for **After Final Communications**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal
Drive, Arlington, VA., Sixth Floor (Receptionist).

Chau Nguyen
Patent Examiner
Art Unit 2176


SANJIV SHAH
PRIMARY EXAMINER